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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,833	07/21/2003	Richard A. Schumacher	MEMORY-0028	4785

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MILLEN, WHITE, ZELANO & BRANIGAN, P.C.
2200 CLARENDON BLVD.
SUITE 1400
ARLINGTON, VA 22201

EXAMINER

ANDERSON, REBECCA L

ART UNIT	PAPER NUMBER
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1626

MAIL DATE	DELIVERY MODE
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11/23/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/622,833

Applicant(s)

SCHUMACHER ET AL.

Examiner

Rebecca L. Anderson

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-7, 36, 37, 51, 52, 66, 67, 81, 82, 96, 97 and 111-143 is/are pending in the application.
- 4a) Of the above claim(s) 122, 123, 135, 136 and 142 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 113 is/are allowed.
- 6) ☒ Claim(s) 2, 5, 36, 37, 81, 82, 115, 120 and 121 is/are rejected.
- 7) ☒ Claim(s) 2-7, 36, 37, 51, 52, 66, 67, 81, 82, 96, 97, 111, 112, 114-121, 124-134, 137-141 and 143 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 2-7, 36, 37, 51, 52, 66, 67, 81, 82, 96, 97, 111-143 are currently pending in the instant application. Claims 122, 123, 135, 136 and 142 are withdrawn from consideration as being for non-elected subject matter. Claim 113 appears allowable over the prior art of record. Claims 2, 5, 36, 37, 81, 82, 115, 120 and 121 are rejected. Claims 2-7, 36, 37, 51, 52, 66, 67, 81, 82, 96, 97, 111, 112, 114-121, 124-134, 137-141 and 143 are objected to as containing non-elected subject matter.

Response to Amendment and Remarks

Applicants' amendment filed 19 September 2007 to claim 2 has overcome the 35 USC 102(b) rejection of the claim as the claim no longer reads on 3,4-dimethoxy-N-(4-methylcyclohexyl)-benzamine as claim 2 now requires one of the provisos (a)-(e). The requested clarification of the subject matter examined can be found below in the section entitled Elections/Restrictions.

Election/Restrictions

As per the petition decision, the examiner will determine whether the entire scope of the claims is patentable according to MPEP 803.02. Applicants' elected species of N-(3-ethoxy-4-methoxyphenyl)-N-(3-pyridylmethyl)-N-aminobenzoic acid appears allowable over the prior art of record. Therefore, according to MPEP 803.02: should no prior art be found that anticipated or renders obvious the elected species, the search of the Markush-type claim will be extended. If prior art is then found that anticipated or renders obvious the Markush-type claim with respect to a nonelected

species, the Markush-type claim shall be rejected and claims to the nonelected species held withdrawn from further consideration.

The following is a clarification of the scope of the subject matter examined.

The search of the Markush-type claim has been extended to include the products of the formula I as found in claim 132 and the products of claim 113. Additionally, the search of the Markush-type claims have been extended to the non-elected species of 3,4-dimethoxy-N-(4-methylcyclohexyl)-benzenamine and N-(3,4-dimethoxyphenyl)-N'-[3—(2-methyl-4-pyrimidinyl)phenyl]-1,3,5-triazine-2,4-diamine.

As prior art has been found which anticipates the above identified nonelected species of N-(3,4-dimethoxyphenyl)-N'-[3—(2-methyl-4-pyrimidinyl)phenyl]-1,3,5-triazine-2,4-diamine, the Markush-type claims are rejected as follows and the subject matter of the claims drawn to nonelected species held withdrawn from consideration. Claims 2-7, 36, 37, 51, 52, 66, 67, 81, 82, 96, 97, 111-121, 124-134, 137-141 and 143 have been examined to the extent that they are readable on the elected embodiment and the above identified nonelected species. Since art was found on the nonelected species, subject matter not embraced by the elected embodiment or the above identified nonelected species is therefore withdrawn from further consideration.

In order to clarify the scope of the subject matter searched and examined, it is noted that **NOT** all compounds within the scope of the claims in which R3 is H has been searched and examined, R3 as H has only been extended to the following two species: 3,4-dimethoxy-N-(4-methylcyclohexyl)-benzenamine and N-(3,4-dimethoxyphenyl)-N'-[3—(2-methyl-4-pyrimidinyl)phenyl]-1,3,5-triazine-2,4-diamine.

It has been determined that the entire scope claimed is not patentable.

Claim Objections

Claims 2-7, 36, 37, 51, 52, 66, 67, 81, 82, 96, 97, 111, 112, 114-121 and 124-131 are objected to as containing non-elected subject matter. Claims 2-7, 36, 37, 51, 52, 66, 67, 81, 82, 96, 97, 111, 112, 114-121 and 124-131 presented drawn solely to the elected invention for search and examination as identified supra would overcome the instant objection.

Claims 132-134, 137-141 and 143 are objected to as being dependent upon a rejected base claim, but would appear allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 2 is objected to because of the following informalities: specifically, claim 2 has various informalities, such as on page 7 wherein "substituted unsubstituted" is found multiple times and should be amended to "substituted or unsubstituted".

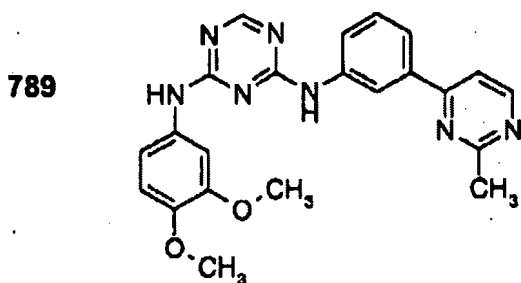
Appropriate correction is required.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2, 5, 36, 37, 81, 82, 115, 120 and 121 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 01/25220.

WO 01/25220 discloses the compound #789, page 117:



which corresponds to applicants invention

wherein R1 is methyl; R2 is methyl; R3 is H, R4 is heteroaryl substituted with R5-L wherein L is a divalent aliphatic radical having 1 carbon atom wherein one -CH2- groups is replaced with -NR6-; R6 is H; and R5 is aryl which is substituted with heteroaryl having one or two rings and a total number of 5 to 10 ring atoms wherein at least one of the ring atoms is a heteroatom and which is substituted or unsubstituted; provided that (c) R4 is at least monosubstituted by R5-L in which R5 is aryl or a heterocyclic group each being substituted by cycloalkyl, aryl or heteroaryl. WO 01/25220 also discloses pharmaceutical compositions on page 178 with doses of 0.5 to 75 mg/kg. The disclosed range of 0.5 to 75mg/kg anticipates the claimed range as the range overlaps with applicants claimed range and discloses the claimed range with "sufficient specificity", see MPEP 2131.03.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (571) 272-0696. Mrs. Anderson can normally be reached Monday through Friday from 6:00am until 2:30pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph K. McKane, can be reached at (571) 272-0699.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1626

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*/Rebecca Anderson/
Primary Examiner, AU 1626*

19 November 2007

Rebecca Anderson
Primary Examiner
Art Unit 1626, Group 1620
Technology Center 1600